



REMARKS

I. PENDING CLAIMS

Claims 1-6 and 36 are pending in this application after entry of the present amendment.

Because the present amendment does not raise new issues requiring further consideration or search, or raise the issue of new matter, and because this amendment places the application in better form for appeal, entry of this amendment is appropriate, and is respectfully requested.

II. REJECTION OVER SARGENT ET AL.

In paragraph 2 of the Office action, the Examiner has rejected claim 36 as obvious under 35 U.S.C. § 103(a) over Sargent et al. (U.S. Patent No. 5,234,466). Applicants respectfully traverse this rejection and request reconsideration and withdrawal thereof.

If, as the Examiner insists, claim 36 is not entitled to the benefit of the filing date of the '466 patent because the '466 patent lacks antecedent basis for the process streams recited in claim 36, then it is incumbent on the Examiner to provide some reference teaching (or provide a affidavit memorializing the Examiner's personal knowledge under 37 C.F.R. § 1.104(d)) that motivates one of ordinary skill in the art to adapt the disclosure of Sargent et al. to these process streams.

The Examiner has consistently held (incorrectly, in Applicants' view) that the Sargent et al. disclosure is limited to bleaching solutions when assessing whether Applicants' claims are entitled to benefit of the Sargent et al. filing date, and then taking a much more expansive view of the disclosure of Sargent et al. when

evaluating obviousness. Applicants submit that this double standard as to the teachings of Sargent et al. is improper, and would not be sustained on appeal. Either Sargent et al. suggests that the process disclosed therein can be applied to any paper process stream where acid has been traditionally used (in which case the disclosure of Sargent et al. reasonably indicates that the inventors had possession of the presently claimed invention as of the filing date of Sargent et al.), or it does not suggest that the process disclosed therein can be so applied, and the Examiner must cite another reference and provide motivation to combine its teachings with those of Sargent et al. in order to make a sustainable rejection for obviousness. In either case, the obviousness rejection of claim 36 in the Office action is erroneous and should be withdrawn.

III. REJECTION OVER LINDSTROM ET AL. IN VIEW OF SARGENT ET AL.

In paragraph 3 of the Office action, the Examiner has rejected claims 1-6 under 35 U.S.C. § 103(a) as obvious over Lindstrom et al. in view of Sargent et al. Applicants respectfully traverse this rejection and request reconsideration and withdrawal thereof.

Applicants do not dispute that it is known in the art to regulate pH of papermaking process solutions with aluminum sulfate. However, to the extent that Sargent et al. does not sufficiently disclose the subject matter of claims 1-6 for a claim to priority of the '466 patent to be proper, it also does not teach or suggest that alum in these processes could be replaced by urea sulfate. Once again, the Examiner takes a literal reading of the disclosure of Sargent et al. for purposes of determining priority, and then an expansive reading of Sargent et al. for determining obviousness.

However, once again, it is not sufficient to simply make conclusory statements that alum replacement would have been obvious without some teaching or suggestion in the cited art to do so. By denying Applicants' priority claim, the Examiner takes the position that Sargent et al. does not provide such motivation. Certainly Lindstrom et al. does not suggest alum replacement. It is not enough to simply state that it is obvious to replace one pH modifier with another without regard to the underlying chemistry, unpredictable downstream effects, and the like, that can result not just from the addition of urea sulfate, but also from the removal of alum from the process. This is particularly true where, as the Examiner admits, alum performs more than just a pH regulation function when used in paper processing streams. Applicants were the first to discover that urea sulfate could, in fact, be used as a replacement for alum without such effects.


No other references have been cited in the rejection; if the Examiner has personal knowledge of facts that would suggest that such replacement is desirable and would not otherwise interfere with paper processing operations, he should have made these facts of record in a declaration or affidavit under 37 C.F.R. § 1.104(d). Since he has not done so, the only place such a suggestion could have come from on this record is the Examiner's hindsight reconstruction of Applicants' claims. Hindsight is not the appropriate standard for obviousness under the statute, however, and the Examiner's rejection is erroneous and should be withdrawn.

Applicants respectfully submit that the present claims are in condition for immediate allowance; an early notification thereof is respectfully requested.

If the Examiner has any further questions concerning this application, or if he believes that further issues remain to be resolved, he is invited to contact the undersigned before issuance of an Advisory Action so that these issues can be resolved and the application passed to issue expeditiously.

The Commissioner is hereby authorized to charge any deficiencies or credit any overpayment to Deposit Order Account No. 11-0855.

Respectfully submitted,



Bruce D. Gray
Reg. No. 35, 799

KILPATRICK STOCKTON LLP
Suite 2800, 1100 Peachtree Street
Atlanta, Georgia 30309-4530
(404) 815-6218